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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AnAerobics, Inc.

Serial No. 76/092,581

Stephen B. Salai of Harter Secrest & Emery LLP for
AnAerobics, Inc.

Linda M. King, Trademark Examining Attorney, Law Office 101
(Jerry L. Price, Managing Attorney).

Before Cissel, Bucher and Holtzman, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

AnAerobics, Inc. seeks to register the term ANAEROBICS
on the Principal Register for "waste treatment services,"
in International Class 40.¹

This case is now before the Board on appeal from the
final refusal to register based upon the ground that the
term ANAEROBICS is merely descriptive under Section 2(e)(1)

¹ Application Serial No. 76/092,581 was filed on July 20,
2000, based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

of the Lanham Act, 15 U.S.C. §1052(e)(1), and furthermore, that even if applicant could claim benefit of 37 C.F.R. § 2.41, applicant has not made a sufficient showing of acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f) to overcome the underlying refusal to register.

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

While much of the argumentation between applicant and the Trademark Examining Attorney during the course of prosecution of this application focused on whether or not the term ANAEROBICS is generic for the recited services, we are compelled to answer only whether this term is merely descriptive under Section 2(e)(1) when applied to applicant's waste treatment services.

As to the relevant meaning of the word "anaerobic," applicant and the Trademark Examining Attorney seem to agree on the basic science. Anaerobic bacteria (or anaerobe) is bacteria that does not live or grow in the presence of oxygen. Similarly, using a series of entries from the Nexis database, the Trademark Examining Attorney has shown that anaerobic digestion consists of a series of

microbiological processes that convert organic compounds (e.g., residue from livestock farming) into biogas (to generate heat and/or electricity), digested sludge (e.g., fiber for conditioning soil) and liquid fertilizer. At the heart of the process is a digester or reactor - a completely sealed chamber devoid of free oxygen and light that is inoculated with anaerobic bacteria. Moreover, applicant owns proprietary technology applying these principles and processes to high-rate, high-strength wastewater treatment facilities.

Inasmuch as the expression "anaerobic digestion" names a particular waste treatment process, the pluralized term ANAEROBICS clearly conveys information about the waste treatment services using such processes. Indeed, in its appeal brief, applicant concedes this term may well be *merely* descriptive of its processes. (Appeal brief, pp. 4, 5, 7 - 10). Moreover, while not required to demonstrate that the term as used by applicant is generic, we find that the Trademark Examining Attorney has made the case that this term is *highly* descriptive when applied to the recited services.

In order to overcome the refusal under Section 2(e)(1) of the Act, applicant has submitted the declaration of its president, Edward H. Heslop, attesting to the fact that the

term has become distinctive of applicant's services due to more than five years of exclusive and continuous use in commerce by applicant.

Initially, we must agree with the Trademark Examining Attorney that inasmuch as this is still an Intent-To-Use application where no allegation of use has been made, this declaration is unavailing for applicant.

Applicant concedes that it has not yet filed an Amendment to Allege Use under Section 1(c) of the Act. Nonetheless, applicant argues that it is entitled to file a claim of acquired distinctiveness in this application. Unfortunately for applicant, that is not the law.

As noted by the Trademark Examining Attorney, in order to overcome a refusal under Section 2(e) with a showing of acquired distinctiveness, the only other option for the owner of an Intent-to-Use application is to claim that the established distinctiveness of a mark in use in commerce in connection with related goods or services will transfer to applicant's use of that mark in connection with the services identified in the affected Intent-To-Use application. Under this alternative, applicant would have to establish, by appropriate evidence, the extent to which the services recited in this Intent-To-Use application are related to the goods or services in connection with which

the mark is distinctive, and that there is a strong likelihood that the mark's established trademark function will transfer to the related goods or services when use in commerce occurs herein. See In re Rogers, 53 USPQ2d 1741 (TTAB 1999).

In view of the underlying facts and the procedural posture of this case, the question of acquired distinctiveness is moot. However, in order to render a complete opinion, we will now consider applicant's claim of acquired distinctiveness, assuming for this discussion that applicant qualified under Section 1(c) of the Act by having already filed an Amendment to Allege Use, or had established its use of the identical mark on related goods or services for some period of time, and that such acquired distinctiveness transferred to the instant service mark usage.

As discussed above, applicant's mark must be deemed to be highly descriptive. The greater the descriptiveness of the term, the greater the evidence necessary to prove acquired distinctiveness. See Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Thus, the evidence necessary for applicant to prove acquired distinctiveness is great indeed.

After reviewing the entire record, we find that applicant has not met its burden of demonstrating acquired distinctiveness. Applicant argues that it has made a *prima facie* showing of distinctiveness through its statement that applicant has made substantially exclusive and continuous use of the mark in commerce for more than five years. However, the statute states that the Commissioner *may* accept such a statement as proof of acquired distinctiveness, not that the Commissioner *must* accept it.² In this case, because of the high degree of descriptiveness of the term sought to be registered, much more (e.g., empirical evidence) would be required.

Decision: The refusal to register is affirmed.

² 37 C.F.R. § 2.41(b): "In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as *prima facie* evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as *prima facie* evidence of distinctiveness. In each of these situations, however, further evidence may be required." [emphasis supplied].